II. Remarks

Claims 1-22 are pending in this application. Claims 1, 10, and 12 have been amended. Claims 20-22 have been added.

Reconsideration of this application in light of the above amendments and the following remarks is requested.

Rejection[s] Under 35 U.S.C. §103

Claim 1

Claim 1, as amended, recites

> *A telecom test device for connecting to a telephone line carrying an information stream, the device comprising:*
> *a measurement system connected to the device, wherein the measurement system can make a determination of a minimum period from the information stream;*
> *a first circuit for determining a transmission technology from the minimum period, wherein the transmission technology is determined from a plurality of possible transmission technologies, each associated with a different transmission rate; and*
> *a second circuit for selectively connecting the device to the telephone line in response to the determination of the transmission technology.*

Claim 1 was rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,556,661 to Ingalsbe et al. ("Ingalsbe") in view of U.S. Patent No. 5,245,343 to Greenwood et al. ("Greenwood"). Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP § 2142:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

The Ingalsbe and Greenwood patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither Ingalsbe nor Greenwood teaches the transmission technology is determined from a plurality of possible transmission technologies, each associated with a different transmission rate as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met. Ingalsbe describes "a frequency counter function for determining whether data is present on the telecommunication line," (col. 2, lines 25-27, emphasis added) but not, determining a transmission technology from the minimum period, wherein the transmission technology is determined from a plurality of possible transmission technologies, each associated with a different transmission rate.

Thus, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn. Claims 2-9 and 20-22 depend from and further limit claim 1 and therefore are also in condition for allowance.

Claim 10.

Claim 10, as amended, recites

> *A software program for use by a telephone test device for connecting to a telephone line carrying an information stream, the device including a measurement system for making a determination of a minimum period from the information stream, the software program comprising instructions for:*
>
> *converting the minimum period into a transmission rate measurement;*
>
> *determining a transmission technology from the transmission rate measurement, wherein the transmission technology is determined*

from a plurality of possible transmission technologies, each associated with a different transmission rate measurement;

comparing the transmission technology with a set of rules;

selectively connecting the analysis device to the telephone line according to the rules.

Claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,556,661 to Ingalsbe et al. ("Ingalsbe") in view of U.S. Patent No. 5,245,343 to Greenwood et al. ("Greenwood"). Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 10.

As the PTO recognizes in MPEP § 2142:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

The Ingalsbe and Greenwood patents cannot be applied to reject claim 10 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither Ingalsbe nor Greenwood teaches the transmission technology is determined from a plurality of possible transmission technologies, each associated with a different transmission rate measurement as is claimed in claim 10, it is impossible to render the subject matter of claim 10 as a whole obvious, and the explicit terms of the statute cannot be met. Ingalsbe describes only "a

frequency counter function for determining whether data is present on the telecommunication line" (col. 2, lines 25-27, emphasis added).

Thus, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn. Claim 11 depends from and further limits claim 10 and therefore are also in condition for allowance.

Claim 12.

Claim 12, as amended, recites

> *A method for determining a data transmission technology on a transmission medium, the method comprising:*
> *receiving a high-rate synchronization signal for providing a plurality of period increments, the high-rate being greater than or equal to a minimum pulse for data on the transmission medium;*
> *counting the period increments from the high-rate synchronization signal during a pulse of data on the transmission medium;*
> *determining the data transmission technology from the counted period increments, wherein the data transmission technology is determined from a plurality of possible data transmission technologies, each associated with a different data transmission rate.*

Claim 12 was rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,556,661 to Ingalsbe et al. ("Ingalsbe") in view of U.S. Patent No. 5,245,343 to Greenwood et al. ("Greenwood"). Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 12.

As the PTO recognizes in MPEP § 2142:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

The Ingalsbe and Greenwood patents cannot be applied to reject claim 12 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither Ingalsbe nor Greenwood teaches the data transmission technology is determined from a plurality of possible data transmission technologies, each associated with a different data transmission rate as is claimed in claim 12, it is impossible to render the subject matter of claim 12 as a whole obvious, and the explicit terms of the statute cannot be met. Ingalsbe describes only "a frequency counter function for determining whether data is present on the telecommunication line" (col. 2, lines 25-27, emphasis added).

Thus, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn. Claims 13-19 depend from and further limit claim 12 and therefore are also in condition for allowance.

New Claims

Claims 20-22 have been added to further clarify the scope of the invention. Support for the new claims can be found in the original specification.

Conclusion

It is clear from all of the foregoing that independent claims 1, 10, and 12 are in condition for allowance. Dependent claims 2-9, 11, and 13-22 depend from and further limit independent claims 1, 10, and 12 therefore are allowable as well.

An early formal notice of allowance of claims 1-22 requested.

Respectfully submitted,

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